

REMARKS:

Claims 1-34 remain pending in the application.

By this Amendment, claims 1, 17, 33, and 34 have been amended to more particularly point out and distinctly claim the invention. Applicants expressly reserve the right to pursue broader claims in this or another application.

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,038,668 to Chipman, et al in view of U.S. Patent No. 6,094,680 to Hokanson and U.S. Patent No. 6,081,840 to Zhao. This rejection is respectfully traversed for the reasons discussed below.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,038,668 to Chipman, et al (“Chipman”) in view of U.S. Patent No. 6,094,680 to Hokanson (“Hokanson”) and U.S. Patent No. 6,081,840 to Zhao (“Zhao”).

This rejection is respectfully traversed.

Claim 1 has been amended to recite limitations including:

determining, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, whether the product data requested by the particular user should be migrated from a seller database to a storage location that is closer to the identified location of the particular user than the seller database; and
if it is determined that the product data should be migrated, initiating the migration of the product data requested by the particular user from the seller database to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database.

Chipman, Hokanson, and Zhao, whether considered together or in combination, fail to disclose or suggest all of the limitations of claim 1, including the specific limitations included above. For example, Chipman, Hokanson, and Zhao fail to disclose or suggest

determining whether the product data should be migrated closer to a user based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user.

In light of the above, it is respectfully submitted that claim 1, and claims 2-16 depending from claim 1, are in condition for allowance, and notice to that effect is respectfully requested.

Claims 17, 33, and 34, as amended, each include limitations similar to the limitations of claim 1 discussed above. Therefore, the discussion above in connection with claim 1 applies equally to claims 17, 33, and 34.

Applicant also maintains previously-presented arguments for the patentability of the claims over the cited references. It is, again, respectfully requested that if the present rejection is maintained, that the next Office Action include clarification that directly answers the arguments twice-before presented in the Responses filed 26 August 2005 and 21 February 2006 and incorporated herein by reference. The amendments and arguments presented herein should not be construed as a concession of any type. Rather, Applicant respectfully submits that the claims are presently amended in order to expedite allowance of this long-pending Application.

In light of the discussion above, it is respectfully submitted that claims 1-34 are in condition for allowance. Accordingly, Applicants respectfully request that the rejection of claims 1-34 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-34 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Enclosed herewith is a Petition for Extension of Time and a Request for Continued Examination (RCE). The RCE includes an authorization to charge the \$790.00 fee for the RCE and \$450.00 fee for a two-month extension of time to **Deposit Account No. 500777**. If the extension of time is missing or is insufficient for allowing this Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

4/18/06
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